

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL P. DANIELS,
YEN-LANE CHEN, ALBERT I. EVERAERTS,
STEPHEN E. KRAMPE and JAMES K. YOUNG

Appeal No. 2003-1889
Application No. 09/367,455

ON BRIEF

Before WALTZ, DELMENDO and PAWLIKOWSKI, **Administrative Patent Judges.**

PAWLIKOWSKI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-10.

On page 2 of the Brief, appellants state that the claims stand or fall together. In the Brief, appellants provide arguments only for the subject matter of claim 1. We observe, in the Reply Brief, that appellants have separately argued claims 1, 8, 9, 10. However, 37 CFR § 1.192 (c)(7) and (8)(2001) pertains to arguments provided in the Brief in

response to action by the examiner, and therefore does not pertain to arguments presented later in a Reply Brief. In effect, the examiner has not been given an opportunity to respond to the separate arguments regarding claims 8, 9, and 10 set forth in the Reply Brief. Therefore, pursuant to 37 CFR § 1.192 (c) (7) and (8) (2001), we only consider claim 1 in this appeal. See also, In re Dance, 160 F.3d 1339, 1340 n.2, 48 USPQ2d 1635, 1636 n.2 (Fed. Cir. 1998).

Claim 1 is set forth below:

1. A wet stick pressure sensitive adhesive comprising the polymerization product of:

(a) about 30 to about 70 parts by weight of an (meth)acrylate ester monomer wherein the (meth)acrylate ester monomer, when homopolymerized, has a Tg of less than about 10°C;

(b) about 70 to about 30 parts by weight of a hydrophilic acidic comonomer; and

(c) about 10 to 100 parts based on 100 parts (a)+(b) of a non-reactive plasticizing agent,

wherein the pressure sensitive adhesive adheres to wet substrate surfaces.

The examiner relies upon the following reference as evidence of unpatentability:

Blake

4,569,960

Feb. 11, 1986

Claims 1-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Blake, or under 35 U.S.C. § 103, as being obvious over Blake.

can be classified as a wet stick adhesive that can adhere to a wet substrate surface.

Moreover, claim 1 is a product-by-process claim. A product-by-process claim is not a method claim, but rather a product claim in which the product is defined, in whole or in part, by the process used to make the product. In *ex parte* proceedings before the PTO, product-by-process claims are interpreted as not being limited by the process steps recited in the claims, because product-by-process claims define a product rather than a process. See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 965-66 (Fed. Cir. 1985). It follows, accordingly, that any reference in the prior art to the same, or similar compound, no matter how made, may render the claim anticipated or obvious. Thus, the claim is interpreted as covering the claimed product, no matter how it is made. In the instant case, Blake discloses a similar or identical compound, which therefore establishes a prima facie case of anticipation or obviousness.

With regard to the claimed properties of "wet" stick and "adheres to wet substrate surfaces", we note that where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require appellants to prove that subject matter shown in the prior art does not necessarily possess the characteristics relied on. In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); See also, In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. 1990); and Ex Parte Gray, 10 USPQ2d 1922, 1925 (Bd. Pat. App. & Int. 1989). Also, it is well settled that the Patent Office can require

appellants to prove that a function or property relied upon for novelty is not possessed by prior art compounds otherwise meeting the limitations of the claims. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Accordingly, absent such proof, as in the present case, we are not convinced by appellants' arguments that Blake's product does not have the properties of (1) "wet" stick and (3) the ability to adhere to wet substrate surfaces.

With regard to the asserted difference (2) of a wet-stick pressure sensitive adhesive comprising a polymerizable product of a non-reactive plasticizing agent, Blake discloses that the adhesive comprises the blended reaction product of components (a), (b), and (c). See column 2, lines 42-68 and column 3, lines 1-18 of Blake. Component (b) of Blake is an ethoxylated plasticizing component. Appellants do not dispute that this component is the same/similar to their claimed plasticizing agent. Assuming, *arguendo*, that the plasticizing agent of Blake is not the same/similar as claimed by appellants, appellants' argument made on page 3 of the Reply Brief that the plasticizing component is not part of the polymerizable mixture indicates that the plasticizing agent of Blake is a non-reactive plasticizing agent and regardless, would not alter the structure of the product. Furthermore, as mentioned supra, the claim is interpreted as covering the claimed product, no matter how it is made. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 965-66 (Fed. Cir. 1985). It therefore follows that because Blake discloses a similar compound, no matter how made, appellants' claim 1 is rendered anticipated or obvious over Blake.

II. Conclusion

We sustain the examiner's refusal to allow claims 1-10.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

THOMAS A. WALTZ
Administrative Patent Judge

Romulo H. Delmendo) BOARD OF PATENT
) APPEALS AND
ROMULO H. DELMENDO) INTERFERENCES
Administrative Patent Judge)

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